DOCKET NO. 13529STUS01U (NORT10-00322) **PATENT**
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Steve Nixon, et al.
Serial No.:	09/735,499
Filed:	December 14, 2000
For:	ENHANCED UNIFIED MESSAGING SYSTEM WITH A QUICK VIEW FACILITY
Group No.:	2172
Examiner:	Namitha Pallaii
Confirmation No.:	5769

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. This review is requested for the reasons stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all of the claims.

Claims 1, 2, 7, 8, and 12-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Helfman (U.S. Patent No. 6,396,513). Claims 3-6 and 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfman in view of Sylvan (U.S. Patent No. 5,943,055). The rejections are respectfully traversed.

102 Rejection:

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicants note that independent Claim 1 was previously amended to recite "the means for determining being further operable to determine that one or more of the messages is new but has an associated notification that has been cleared . . . ." Independent Claims 14, 15, and 17-19 have been similarly amended. Applicants respectfully submit that Helfman fails to disclose or suggest at least this limitation. Applicants particularly note that in Appeal 2007-1355, July 17, 2007, the BPAI specifically found that Helfman discloses "a list of message notifications associated only with those messages determined to be *new* (*see* Fig. 3A, window 40, i.e., the "unread/tot" column indicating the number of *unread* messages) *and* for which a notification has not been cleared . . ." Decision, pages 4-5.

The final Office Action argues that, in Helfman, when a new message arrives in the mailbox, an associated notification (such as an alarm for the mailbox) is generated and displayed. After display, the notification is "cleared" (presumably by the mere display of the alarm notification). See, final Office Action, page 10, page 3 (citing Helfman, Col. 4, lines 45-57). The final Office Action appears to interpret Helfman's teaching that when a parameter for a mailbox exceeds some respective threshold and an alarm is triggered and then "cleared," (Helfman, Col. 4, lines 45-57), this

is somehow equivalent to determining one or more messages to be new which have an associated notification that has been cleared (which determination is from the stored message status information). Applicants respectfully disagree. The final Office Action cites to no portion of Helfman which would support the interpretation that the mere triggering of an alarm (whether or not displayed) is equivalent to determining that one or more messages is new and have an associated notification that is "cleared" – as used and defined by the Applicants' specification. The cited portion of Helfman simply does not disclose this specific element recited in Applicants' claims.

The Office has previously interpreted Helfman as disclosing determining that a message is both "new" and that a notification for that message has not been cleared (Office Action dated June 21, 2010 at page 2). Now, the final Office Action takes the position that Helfman discloses determining that is both "new" and that a notification for that message has been cleared. To the contrary, in the previously-asserted interpretation of Helfman's system, once a notification is cleared (i.e., the unread/tot column is reset to zero because the message has been read), the message can no longer be separately determined as "new." Thus, the final Office Action's new interpretation of Helfman is contradictory to the previous interpretations, and is unsupported by the cited portion of Helfman.

For at least these reasons, independent Claim 1 (and similar independent Claims 14, 15 and 17-19) are not anticipated by Helfman. Likewise, the dependent claims, which include the elements and limitations of their respective base independent claims, are also patentable over Helfman. Accordingly, Applicants respectfully request withdrawal of the § 102(e) rejection.

103 Rejection:

As noted above in connection with the rejection under 35 U.S.C. § 102, Applicants have amended Claim 1 to recite "the means for determining being further operable to determine that one or more of the messages is new but has an associated notification that has been cleared . . . ." Applicants respectfully submit that the combination of Helfman and Sylvan does not disclose or suggest at least this limitation. Sylvan provides a user with a list of all messages in the messaging system, rather than a list of message notifications associated only with those messages determined to be new and for which a notification has not been cleared. Indeed, Applicants submit that Sylvan is incapable of determining which messages have, or have not, had an associated message notification cleared. Thus, Sylvan cannot provide "the means for determining being further operable to determine that one or more of the messages is new but has an associated notification that has been cleared . . . .," and the 103 rejections should be withdrawn.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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